

REMARKS

Claims 1-15 are pending in this application. Claims 14 and 15 were rejected by the Examiner. The Applicant has elected to restrict examination to Claims 14 and 15 only, and withdraws claims 1-13 from consideration without prejudice. The Applicant reserves the right to prosecute the withdrawn claims in a continuing application or other filing.

The Examiner is respectfully requested to reconsider the rejection of this Application in light of the foregoing remarks.

Claim Rejections

35 U.S.C. § 103

Claims 14-15

The Examiner rejected Claims 14 and 15 under 35 U.S.C. §103(a) as being unpatentable over Hansburg (US Patent No. 3,604,711) in view of Pischette (US Patent No. Des 378,279).

In making the rejection the Examiner stated:

With respect to claim 14, Hansburg discloses the use of a putting guide (18) that is used for practicing putting. The putting aid (18) is placed parallel to a putting line (the putting line is considered as the location line wherein the ball and the putter are located as shown on Fig. 1). Hansburg shows a golfer putting from a point in relation to his putting aid (18) and a hole (21) and he states that his putting aid (18) is a tape (see column 1, line 35) but he fails to explicitly state that his tape has numerical marks. However, Pischette discloses a golf measuring apparatus with numerical marks (see Figs. 1-2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide numerical marks on the Hansburg's tape in order to know how far the distance is between the ball and the hole so that the golfer could estimate how much force he would need to exert on his golf swing for the golf ball to roll into the targeted hole. With respect to the step of advancing to a subsequent numerical marking on the putting aid and putting from the subsequent numerical marking on the putting aid, it is very well known in the art that when putting, the golf ball may fall short of the hole which would require additional putting from subsequent markings. It would have been obvious to one of ordinary skill in the art at the time the invention was made to practice putting at different distances away from the hole because ones target orientation and interaction with the target is the single most important criteria for any developing golfer.

With respect to claim 15, a golfer's ability to strike a ball with the club head so that it could roll surely and truly to the target is only enhanced by repeatedly practicing his putting technique. It would have been obvious to one of ordinary skill in the art at the time the invention was made to putt from a first distance to a subsequent distance for any number of times, including three times, from different locations because in order for a golfer to have a better chance to produce the proper speed and direction necessary

for each specific shot, he has to practice his putt several times at different locations to be able to roll the ball into the hole.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103, the Examiner must demonstrate that there is a suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine the reference teachings. Furthermore, the prior art references must teach or suggest all of the claim features when combined. It is well settled law that the prior art itself must provide the motivation for a proposed alteration of a reference. Ex parte Chicago Rawhide Manufacturing Co., 220 U.S.P.Q. 351, (B.O.P.A. 1984). Moreover, the suggestion must be plain and clear or the rejection is untenable. Fromson v. Offset Plate, Inc., 225 U.S.P.Q. 26, 32 (Fed. Cir. 1985); Kimberly-Clark Corp. v. Johnson & Johnson, 223 U.S.P.Q. 603, 610 (Fed. Cir. 1984). The Examiner is not free to pick bits and pieces from the prior art and, with the hindsight benefit of applicants' disclosure, attempt to reconstruct the invention. Orthopedic Equipment, Inc. v. U.S., 217 U.S.P.Q. 193, 199 (Fed. Cir. 1983).

The device described in the Hansburg reference is a tape or cord which is placed on the ground and provides a straight line path from the ball position to the hole as indicated in the reference. As the Examiner correctly notes, there is no indication of numerical markings on the cord which would allow the golfer to put with assurance from the same place along the cord in order to practice putting as is recited in Applicant's independent claim 14. Indeed, there is no suggestion or motivation in the Hansburg reference that there are any markings of any kind on the tape/cord of the Hansburg device. As such, the golfer could

not utilize the Hansburg device for putting in the same way as the Applicant's claimed invention as claimed in Applicant's independent claim 14.

The device illustrated in the Pischette reference is essentially, and simply, a measuring tape to measure distances which is mounted to a base with a small notepad. As the patent is a design patent, there is really no way of discerning specifically what function is intended by the use of the Pischette device beyond being a simple distance measuring device as all measuring tapes are. There is no suggestion or motivation in either the Hansburg or Pischette references that would lead one of ordinary skill in the art to combine a measuring tape as in Pischette, with a straight line tape/cord device as in Hansburg.

On the other hand, Applicant's claimed invention as recited in independent claim 14 recites a "method of training a golfer in putting with a putting aid having ***numerical spaced markings on*** the putting aid" (emphasis added), which is neither taught nor suggested in the Hansburg or Pischette references, and accordingly, Applicant's independent claim 14 is patentably distinct from the Hansburg reference, whether taken alone, or in combination with the Pischette reference.

Applicant's claim 15 depends from Applicant's patentable independent claim 14 and is therefore patentable for at least the same reasons as Applicant's patentable independent claim 14. In addition, Applicant's dependent claim 15 recites putting three times from each numerical mark. As the Examiner rightly notes, there are no numerical markings taught or suggested on the device described in Hansburg. Therefore, the Hansburg device could not be used in the same way as the Applicant's device as claimed in dependent claim 15 since a

golfer would have no way of returning to the same spot on the Hansburg device in order to repeat putting from that spot any number of times, let alone three.


CONCLUSION

In view of the foregoing remarks, it is believed that this Application is now in condition for allowance. Early and favorable reconsideration is respectfully solicited.

If the Examiner has any questions regarding the foregoing amendment and remarks, or if prosecution of this Application could be furthered by a telephone interview, the Examiner is requested to telephone the Applicants' undersigned attorney.

Respectfully submitted,

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